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C46

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/629,547	04/09/96	TAKAHASHI	ATS-032 CON/

PM82/1218

EXAMINER

LUONG, V

ART UNIT	PAPER NUMBER
3682	

DATE MAILED: 12/18/00 43

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
43	

DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

1.  The communication filed 10/3/2000 is informal/non-responsive for the reason(s) checked below and should be corrected. APPLICANT IS GIVEN ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION (WHICHEVER IS LONGER) WITHIN WHICH TO CORRECT THE INFORMALITY.

- a.  The amendment to claim(s) \_\_\_\_\_, filed \_\_\_\_\_, fails to comply with the provisions of 37 C.F.R. 1.121 and is accordingly held to be non-responsive. A supplemental paper correcting the informal portions and complying with the rule is required.
- b.  The paper is unsigned. A duplicate paper or ratification, properly signed, is required.
- c.  The paper is signed by \_\_\_\_\_, who is not of record. A ratification or a new power of attorney with a ratification, or a duplicate paper signed by a person of record, is required.
- d.  The communication is presented on paper which will not provide a permanent copy. A permanent copy, or a request that a permanent copy be made by the Office at applicant's expense, is required, see M.P.E.P. 714.07.
- e.  Other *see attached sheets.*

2.  In accordance with applicant's request, THE PERIOD FOR RESPONSE FROM THE OFFICE ACTION DATED \_\_\_\_\_ IS EXTENDED TO RUN \_\_\_\_\_ MONTH(S).

No further extension will be granted unless approved by the Commissioner. 37 C.F.R. 1.136 (b)

3.  Receipt is acknowledged of papers submitted under 35 U.S.C. 119 which papers have been made of record in the file.

4.  Other

Vinh T. Luong  
Primary Examiner

Art Unit: 3682

1. The request filed on October 3, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/629,547 is acceptable and a CPA has been established. An action on the CPA follows.
2. Newly submitted claims 69-100 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
  - a. Inventions II (new claims 69-100) and I (original claims 1-42 of Reissue Application No. 08/629,547 and/or claims 1-12 of US Patent No. 5,465,635) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by hand (e.g., using the hand to assemble or couple the clutch facing to a transmission. Note that the use of the hand to assemble the flywheel, the clutch, and the transmission, etc. is notoriously well known in the art of, e.g., rebuilding of an automobile engine). Alternatively, the process as claimed can be practiced by another materially different apparatus such as the apparatus of Numata (Japanese Patent Publication No. 57-058,542). On the other hand, the apparatus as originally claimed can be used to practice another and materially different process such as the process of damping the vibration of a crankshaft; or
  - b. Inventions I ((original claims 1-42 of Reissue Application No. 08/629,547 and/or claims 1-12 of US Patent No. 5,465,635) and II (new claims 69-100) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be

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shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product such as the product shown in Japanese Utility Model No. 64-11453 cited by applicant. Alternatively, the product as claimed can be used in a materially different process of using that product such as the process of damping a crankshaft.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 69-100 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The amendment filed on October 3, 2000 canceling all claims drawn to the elected invention by original presentation and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention by original presentation because claims 69-100 are directed to method only.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

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4. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 305-7687**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-7687) on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_  
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 7:30 AM EST to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong  
December 18, 2000



Vinh T. Luong  
Primary Examiner